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Docket No.: 10513-0001-2

IN THE UNITED STATES PATENT & TRADEMARK OFFICE

IN RE APPLICATION OF  
Judi VERNAU, et al

: EXAMINER: PARDO, Thuy N.

SERIAL NO: 09/412,754

:

FILED: OCTOBER 5, 1999

: GROUP ART UNIT: 2175

FOR: APPARATUS FOR CLASSIFYING OR DISAMBIGUATING DATA

RESTRICTION RESPONSE

ASSISTANT COMMISSIONER FOR PATENTS  
WASHINGTON, D.C. 20231

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AUG 16 2002

Technology Center 2100

SIR:

In response to the Restriction Requirement mailed July 17, 2002, Applicants elect with traverse the invention of Group I, consisting of Claims 1, 4, 7, 12, 17, 19-31, 34-36, 39, 43, 50-53, 56, 65, 70 and 73-75 for examination on the merits in the present application.

Applicants respectfully traverse the Restriction Requirement for several reasons.

First, the outstanding Official Action merely includes the conclusory statement that "Group I contains claims directed to ... patentably distinct species" without stating any basis whatsoever in support of such a finding. This is contrary to MPEP §816, which states:

**MPEP §816**

The particular reasons relied on by the examiner for holding the inventions as claimed are either independent or distinct should be concisely stated. A mere statement of conclusion is inadequate. The reasons upon which the conclusion is based should be given....

In the absence of any annunciated basis, it is respectfully submitted that the PTO clearly has not carried forward its burden of proof to establish distinctness.

Secondly, MPEP § 806.04(f) requires:

MPEP § 806.04(f)

Claims to be restricted to different species must be mutually exclusive....

The outstanding Official Action fails to address in any way whether the pending claims recite mutually exclusive characteristics and this failure provides a further basis for traversing the election requirement.

Finally, MPEP § 803 states:

MPEP § 803

If the search and examination of an entire application can be made without serious burden, the Examiner must examine it on the merits, even though it includes claims to distinct or independent inventions.

The claims of the present invention would appear to be part of an overlapping search area. Accordingly, Applicant also respectfully traverses the outstanding restriction requirement on the grounds that a search and examination of the entire application would not place a *serious* burden on the Examiner.

Consequently, Applicants respectfully request this Restriction Requirement be withdrawn.

Accordingly, an examination on the merits of Claims 1-78 is believed to be in order, and an early and favorable action on the merits of these claims is respectfully requested.

Respectfully submitted,

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